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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,176	11/02/2001	Danny Zhong Der Pang		8681

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Danny Z. Pang
1526 W. Flower Avenue
Fullerton, CA 92833

EXAMINER

LIU, SAMUEL W

ART UNIT PAPER NUMBER

1653

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,176

Applicant(s)

PANG, DANNY ZHONG DER

Examiner

Samuel W Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 3 and 8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11-2-01</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Status of the claims

Claims 1-10 are pending.

The following Office Action is applicable to the pending claims 1-10.

IDS

The references listed in IDS filed 2 November 2001 have been considered.

Objection to claims

The disclosure is objected to because of the following informalities:

(1) In claims 3 and 8, "Sequence ID 6" should be changed to "SEQ ID NO:6.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 1-10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites, "decorin dissolved or dispersed"; the recitation is unclear as to whether or not the "dispersed" refers to colloiddally dispersed, e.g., solid substance or water-insoluble liquid colloiddally dispersed in liquid solvent (note that colloidal dispersion is a suspension

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system). The claim should make it clear as to which one, dissolved or dispersed, is applied to said decorin compound. See also claim 6. The dependent claims are also rejected.

Claim 2 recites “naturally derived”; the recitation is unclear as to whether or not it refers to modified from naturally-occurring decorin, or obtained from nature without modification to the decorin. Note that the specification does not define the recitation. See also claim 7.

Claim 3 is not apparent in the recitation “human mature core protein”; is the said protein decorin or a human protein which is highly homologous to decorin polypeptide of SEQ ID NO:6? See also claim 8.

Claim 4 recites “between about 0.5 .mu.g/ml and about 5,000 .mu.g/ml”; the recitation is vague regarding (i) whether or not “.mu.g/ml” refers to a specific *weight unit* that has NOT been defined in the specification and by art in record, or refers to microgram (μg)/ml; and (ii) the term “about” being set forth with a very broad range (0.5 to 5,000) renders the claim indefinite because “about 5,000” can read on “5,900”, and “about 0.5” can read on “near zero”. See also claims 5, 9 and 10.

Claim 6 recites “combat aging”; the recitation is not apparent as to whether or not the “aging” refers to a *skin aging* process; does the combat aging refer to prevent skin aging? Because the aging is an inevitable biological process that cannot be prevented or thoroughly treated, the claim should make it clear regarding to what symptom (*e.g.*, wrinkles of aging skin) the claimed method is directed.

Claim Rejections - 35 USC §102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruoslahti, E. I. et al. (US Pat. No. 5654270).

Ruoslahti et al. teach a pharmaceutical composition comprising decorin (see column 10, lines 8-26) wherein the decorin is recombinantly produced (see Example 1, column 7, lines 62-65, and Figures 3A and 13), as applied to claims 1-2 of the current application.

Claim Rejections - 35 USC §103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruoslahti, E. I. et al. (US Pat. No. 5654270).

Ruoslahti et al. teach a pharmaceutical composition comprising decorin (see column 10, lines 8-26) wherein the decorin is recombinantly produced (see Example 1, column 7, lines 62-65, and Figures 3A and 13), as applied to claims 1-2 of the current application.

Also, Ruoslahti et al. teach advantage of using the composition comprising decorin for cosmetic surgery (see column 9, lines 55-61), as applied to claims 6-7 of the current application.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to be motivated by the above Ruoslahti et al. teachings because cosmetic surgery is considered as one of approaches to reducing skin aging which is the subject matter set forth in the instant claims 6-7. Thus, the skilled artisan would have been inextricably led to developing a method of treating the skin of human against skin aging. Therefore, the claimed invention was *prima facie* obvious to make and use the invention at the time it was made.

Prior Art

The prior art made of record and not currently relied upon in any rejections is considered pertinent to Applicants' disclosure:

Ruoslahti E. et al. (US Pat. No. 5654270) teach a recombinantly produced decorin polypeptide which sequence comprises 2-329 amino acid residues of SEQ ID NO:6 of the current disclosure. Because the first residue of the Ruoslahti's sequence differs from that of SEQ ID NO:6, the Ruoslahti et al. patent is not considered as an anticipatory art over the instant claim 3 by Examiner.

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Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Wei Liu whose telephone number is 571-272-0949.

The examiner can normally be reached from 9:00 a.m. to 5:00 p.m. on weekdays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Christopher Low, can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703 308-4242 or 703 872-9306 (official) or 703 872-9307 (after final). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



Samuel Wei Liu, Ph.D.

February 12, 2004



KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER